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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,710	01/24/2001	Harry C. Morris	DMBC-0003	2728

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT PAPER NUMBER

1775

DATE MAILED: 11/17/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO 14

Office Action Summary	Application No. 09/768,710	Applicant(s) MORRIS, HARRY C.	
	Examiner John J. Zimmerman	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

FOURTH OFFICE ACTION

Amendment

1. This Office Action is in response to Reply Under 37 CFR 1.111 received August 27, 2003. Claims 1 and 6-8 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

4. Applicant has inserted the new limitation "consists essentially of" to describe the electroless nickel layer in the claims. A review of the original disclosure, however, shows that applicant never originally intended to exclude extra constituents from the electroless nickel composition and indeed the original disclosure clearly teaches that the protective layer may

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"comprise" electroless nickel (e.g. see page 3, line 28). The term "comprising" leaves the claims open for the inclusion of unspecified ingredients even in major amounts, *Ex parte Davis, et al.*, 80 USPQ 448 (PTO Bd. App. 1948). Since there was no original concept at the time of filing that the electroless nickel layer should exclude additional constituents, the insertion of the new limitation "consists essentially of" into the claims is new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 8 is rejected under 35 U.S.C. 102(a) as being anticipated by Calnan (U.S. Patent 3,490,314).

7. Calnan discloses electrolessly plating nickel on the entire surface of carbon steel strips which are made into blades (e.g. see column 2, lines 8-11, 65-69).

8. Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanpei (Japanese publication 04-070343) or Kaneko (EP 0 869 200 A2).

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9. Sanpei discloses coating a coiled steel blade with a coating including electroless nickel (e.g. see figures 1-4). Kaneko discloses a prior art process of coating a coiled steel blade with a coating including electroless nickel (e.g. see page 2, lines 25-30). In addition, Kaneko discloses an improved process of electrolessly plating nickel containing compositions on doctor blades which are spirally wound (e.g. see claims 1-7).

10. Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Kaneko (U.S. Patent 6,027,765).

11. Kaneko discloses a prior art process of coating a coiled steel blade with a coating including electroless nickel (e.g. see column 1, lines 29-47). In addition, Kaneko discloses an improved process of electrolessly plating nickel containing compositions on doctor blades which are spirally wound (e.g. see claims 1-4).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei (Japanese publication 04-070343), Kaneko (EP 0 869 200 A2) or Kaneko (U.S. Patent 6,027,765), in view of Nomura (U.S. Patent 6,059,881).

14. Sanpei discloses coating a coiled steel blade with a coating including electroless nickel (e.g. see figures 1-4). Kaneko (EP 0 869 200 A2) discloses a prior art process of coating a coiled steel blade with a coating including electroless nickel (e.g. see page 2, lines 25-30). In addition, Kaneko discloses an improved process of electrolessly plating nickel containing compositions on doctor blades which are spirally wound (e.g. see claims 1-7). Kaneko (U.S. Patent 6,027,765) discloses a prior art process of coating a coiled steel blade with a coating including electroless nickel (e.g. see column 1, lines 29-47). In addition, Kaneko discloses an improved process of electrolessly plating nickel containing compositions on doctor blades which are spirally wound (e.g. see claims 1-4). Sanpei and Kaneko may differ from claim 7 in that they may not show a specific embodiment of a doctor blade with a square edge. Nomura, however, clearly shows that coater blades are conventionally made in beveled or square edge shapes (e.g. see blades in Figures 2 and 3). In view of Nomura, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the blades of Sanpei or Kaneko in either beveled or square edge shapes because Nomura shows these shapes to be obvious variations on coater blade edges in the art.

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15. Claims 1 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calnan (U.S. Patent 3,490,314) in view of Sanpei (Japanese publication 04-070343) or Kaneko (EP 0 869 200 A2).

16. Calnan discloses electrolessly plating nickel on the entire surface of carbon steel strips which are made into blades (e.g. see column 2, lines 8-11, 65-69). Calnan discloses that the cutting edge may be beveled. It would be understood that the non-cutting edge would remain square since it is not sharpened. Thus the strip would have one beveled edge and one square edge. Calnan may differ from the claims in that Calnan may not disclose that his continuous steel strip is coiled. Sanpei (e.g. see Figure 1) and Kaneko (see Figure 1), however, clearly show that when plating continuous strips for blades, it is obvious to coil the strips. In view of Sanpei and Kaneko, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coil the continuous steel strip of Calnan because Sanpei shows that this makes the strip fit more easily in the electroless plating bath container and Kaneko shows that coiling can take up the strip on reels to facilitate continuous production.

Response to Arguments

17. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive.

18. In the sole amendments to the claims, applicant has added the phrase "consists essentially of" to the claims and argues that the compositions of the applied references are excluded by this

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limitation. The examiner notes, however, that the term "consisting essentially of" allows for additional alloying constituents which do not affect the basic and novel characteristics of the invention, *Ex parte Davis, et al.*, 80 USPQ 448 (PTO Bd. App. 1948); *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963), and when applicant contends that modifying components in the prior art compositions are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the basic and novel characteristics of their composition are materially affected by those components, *In re De Lajarte*, 143 USPQ 256 (CCPA 1964). Applicant has not factually shown that the additional constituents of the compositions of the applied art actually do affect the basic and novel characteristics of the invention and therefore applicant's arguments on this issue can be given little weight.

19. In any event, applicant's insertion of the new limitation "consists essentially of" into the claims appears to be new matter. A review of the original disclosure shows that applicant never originally intended to exclude extra constituents from the electroless nickel composition and indeed the original disclosure clearly teaches that the protective layer may "comprise" electroless nickel (e.g. see page 3, line 28). The term "comprising" leaves the claims open for the inclusion of unspecified ingredients even in major amounts, *Ex parte Davis, et al.*, 80 USPQ 448 (PTO Bd. App. 1948). Since there was no original concept at the time of filing that the electroless nickel layer should exclude additional constituents, the insertion of the new limitation "consists essentially of" into the claims is new matter.

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Conclusion

20. Applicant's amendment inserting "consists essentially" into the claims necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (703) 308-2512. The examiner can normally be reached on 8:30am-5:00pm, M-F. The fax phone number is (703) 872-9310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
November 12, 2003